

AMENDMENT
U.S. Appl. No. 10/670,565

REMARKS

Upon entry of the claim amendments, Claims 12-17 will be all the claims pending in the application.

Applicants have canceled Claims 11 and 18 in an effort to expedite the prosecution and without prejudice or disclaimer. Applicants reserve the right to file a continuation application directed to any or all of the canceled subject matter.

Claims 12 and 15 have been amended consistent with the fact that Claim 17 is the sole pending independent claim.

No new matter has been added.

Pending Claims 12-17 are patentable over the applied art for the following reasons.

Independent Claim 17 recites that the water-insoluble component B is a polymer or is an adhesive composition containing a polymer and at least one compound selected from the group consisting of a tackifier and a plasticizer.

As stated in the Amendment filed April 5, 2005, none of the Gleichenhagen document, the Hanninen document or DE '368 discloses a polymer as the water-insoluble component B or a composition containing a polymer as the water-insoluble component B.

The specific tackifying resin disclosed in each of Gleichenhagen, Hanninen and DE '368, such as modified or unmodified rosin resins, including colophony (also called rosin) and hydrogenated disproportionated rosins, are not polymers, but rather blends of different molecules.

It is understood by one of ordinary skill in the art that rosin or colophony is a mixture of about 90% rosin acids and 10% neutral compounds (fatty acid esters, terpene alcohols and hydrocarbons). Resin acids are the major components of natural resin and are typically on the basis of diterpenes. Thus, rosins should not be confused with polymerized rosin esters, the latter representing a specific modification in that the particular type of compound has undergone

AMENDMENT

U.S. Appln. No. 10/670,565

polymerization. Such polymerized rosin esters as disclosed at page 14, line 4, and Example 3 of the specification, are not disclosed in any of Gleichenhagen, Hanninen and DE '368.

Hauber discloses a pressure-sensitive adhesive comprising a sodium ammonium salt of a copolymer of acrylic and methacrylic acids and polyvinylmethylether, two aqueous polyacrylate dispersions, dioctylphthalate, and an aromatic polyglycol ether. Dioctylphthalate is not a polymer.

Furthermore, it is an object of the claimed pressure-sensitive adhesive compositions to provide a water-soluble pressure-sensitive adhesive composition for use in the papermaking process or paper splicing in printing processes. Specifically, the pressure-sensitive adhesive composition should have sufficient tack, while at the same time allowing good peelability.

According to the compositions of Claim 17, this object has been solved by using the combination of a specific component B containing a polymer and a water-incompatible solvent C. As described at page 12, line 12, through page 16, line 12, of the specification, the combination of these two specific components is important in order to supplement the desired properties, in particular, to achieve sufficient tack and sufficient cohesive force. None of the cited art references teaches the criticality of the combination of components B and C in order to achieve these effects.

In the final Office Action mailed July 14, 2005, the examiner indicates at Section No. 6 (page 3) that "applicant is claiming a 'water-insoluble *component B*' and NOT a 'water-insoluble *polymer B*'."

This is incorrect to the extent the examiner was referring to Claim 17. Claim 17 recited and continues to recite that the water-insoluble component B is a polymer or is an adhesive composition containing a polymer and at least one compound selected from the group consisting of a tackifier and a plasticizer.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be

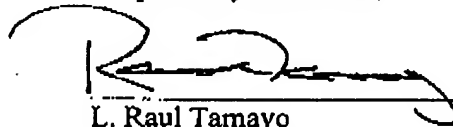
AMENDMENT

U.S. Appln. No. 10/670,565

best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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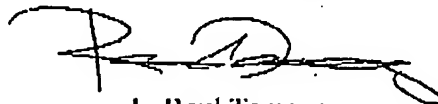
Date: May 17, 2006

CERTIFICATION OF FACSIMILE TRANSMISSION

Sir:

I hereby certify that the above identified correspondence is being facsimile transmitted to Examiner Dr. Kelochi Chidi EGWIM at the Patent and Trademark Office on May 17, 2006, at (571) 273-8300.

Respectfully submitted,



L. Raul Tamayo